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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,636	03/21/2001	Gregory F. Borton	21024000110	3366
20350	7590	08/11/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,636

Applicant(s)

BORTON, GREGORY F.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 5/5/2005 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6, 22, 7-12, 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a 2-prong tests:

- 1) whether the invention is within the technological arts; and
- 2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use or advance the underlying process.

In the present case, claims 1-6, 22, 7-12, and 19-21 do not recite or require the use of any technological component (i.e. a computer) to perform or execute the recited steps to produce a useful, concrete and tangible result (i.e. a report). All of the recited steps could be performed in the mind of a person, i.e.

“a) receiving a plurality of task entries (information or ideas) ;

b) receiving a plurality of resource entries (information or ideas) ... ;

c) receiving mapping information ... ;

d) processing the (1) plurality of task entries (information or ideas), (2) the plurality of resource entries (information or ideas) and (3) the mapping information (ideas) to formulate a business model (better business ideas); and

e) generating a forward-looking report (summary of information or ideas in an orderly manner) after the processing step and related to the business model”.

Clearly, All of the recited steps could be performed in the mind of a person.

Therefore, the claims are directed to non-statutory subject matter because they are not considered to be within the technological arts. The fact that the specification may disclose the use of computers to perform some of the claimed steps is not essential to the determination of whether or not the claims are

statutory under 35 USC 101 because the claims do not recited any use of technology. Therefore, applicant has failed to meet the 1st of the 2-prong tests required to overcome the 35 U.S.C.101 rejection.

To overcome this rejection, the Examiner recommends that Applicant amend the independent claims to incorporate "*using a computer or computer network*" in a significant way in the body of the claim, i.e. in all the steps (a) – (e) mentioned above.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the 1st paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-6, 22, 7-12, 19-21, 23, 24, are rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It's not clear how step (d) above is carried out to formulate a business model since no "activity information" (or business subject or scope) has been entered? what are the relationship of each element in (d) with respect to each other? I.e. the "mapping information" with respect to (1) and (2) previously? No example of a formulated business-model containing 2 items "task" and "resources" has been cited and this would make it difficult for a skilled artisan to make and use the invention.

5. Claims 1-6, 22, 7-12, 19-21, 23, and 24 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, phrases "task entries" and "resource entries" are vague and indefinite because "entries" relate to "information entered" and not the type of information. It appears that the correct term should be "task data" or "task information" wherein the data/information are entered manually or automatically or "entries". Note, that this is demonstrated on page 2, "Description of the specific embodiments", line 31, "begins with entry of setup information 108". In other word, "task information" or "information about task" was entered as "entry". Dependent claims 2-5 (dep. of 1) with phrase related to "entry", are rejected for the same reasons set forth above. Claims 7-12, 19-21, 23, and 24 are rejected for the same reason as shown in claim 1 above.

6. Claim 4 recites the limitations (1) "the activity entry", (2) "the system entry" in line 3. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 6 calls for "wherein the organization comprises at least 1 of a project (s)" which is vague and indefinite since it's well known to a skilled artisan that a project, a single or multiple activities/tasks, can not be called an organization, normally consists of people working in an entity such as company, store, team, etc.

Claim Objections

8. Dependent claims 2, 8-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the

Art Unit: 3629

claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how claim 2 further limit the scope of claim 1 with calls for "doesn't require historical information from a general ledger" or dealt wit cost.

9. Similarly, dep. claim 11 which calls for "an activity-based costing report" is vague and indefinite and does not further limit the scope of the claimed invention which calls for "without requiring historical information from a general ledger for the organization" or cost-related data/information.

As for dep. claims 8-10, it's not clear how these dependent claims further limit independent claim 7.

Independent Claims 23 (medium) and 24 (system) are objected because they contain the language of independent method claim 1 in the body of the claims. Applicant is requested to rewrite claims 23 and 24 in their independent forms.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by MORGAN et al.**

As for claim 23, which deals with a computer-readable medium having computer executable instructions, this is rejected over the computer-readable medium of

Art Unit: 3629

MORGAN et al with executable instructions to carry out the method as shown in Figs. 1,

2. Note that the phrase "for performing the computer-implemented method for activity-based business modeling, this carries little patentable since it's non-functional data.

Moreover, the medium does not connect to a computer and ordering / instructing the computer to carry out the steps.

As for claim 24, which deals with a computer system adapted to perform computer-implementable method, this is rejected over the computer system of Fig. 1 or

2. Note that in an apparatus claim, only structural elements receive patentable weight.

Intended use of the computer system has no patentable weight.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Claims 1-6, 22, 7-12, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over MORGAN et al (US patent 5,799,286).**

As for independent method¹ claim 1, MORGAN et al fairly teaches a method for activity-based business modeling for an organization comprising the steps of {see col. Line 67 (c1:67 for simplification), c2:1-16, c3:59}:

(a) receiving a plurality of task entries, wherein each task entry is comprised of defined types of future action which will generate a result { c2:15-17 "*trending, forecasting, benchmarking*, "; c3:65-c4:2, c19:52-63 "*activity-based forecasting provides future spending information in terms of activities*" };

(b) receiving a plurality of resource entries, wherein each resource entry indicates any associated personnel, hardware, software (or equipment which normally includes computer, computer system and other IT equipment, see also c4:22 "hardware, software") and services {see c4:1-4};

(c) receiving mapping information showing relationship between the task entries and resource entries {see c4:21-23; "relational database 12" on c2:5-25, c5:65, Fig. 7 (114, 126)};

(d) processing the plurality of task entries, resource entries and mapping information to formulate a business model {see Fig. 1 (12), c2:62-67, c4:23-25 "*maps the money spent*"};

(e) generating a forward-looking (or forecast) report after (d) and related to the business model" {see c4:5-10, c5:1-6}.

As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, as shown MORGAN et al c1:37-41, 50-55 or

Art Unit: 3629

c3:55-60, c4:25-42, the use of the historical information from a general ledger in the modeling process is for the benefit of making result more realistic, reliable or accurate since there is cost/cost basis associated with the activities involved. Note also on c3:55-60 which teaches the option of “may include” general ledger for the benefit above if desired but not necessary. Therefore, it would have been obvious to avoid the use of the historical information from a general ledger in the modeling process if making result more realistic, reliable or accurate or associated with cost is not critical or important as compared to other criteria such as speed, etc., or if the general ledger (GL) data is not available. Furthermore, elimination or removal of an element or step for its intended function in a method is well known practice and would have been obvious to an artisan, absent evidence of unexpected results. See *In re Karlson*, 136 USPQ 184, 186.

As for dep. claim 2 (part of 1), which deals with well known organization cost/expense parameter, i.e. overhead, this is fairly taught in Fig. 1 (26) or Fig. 16 (280).

As for dep. claim 3 (part of 1), which deals with well known organization resource parameters, i.e. a system or apparatus, this is fairly taught in Fig. 1 (22) or c4:1-4 (equipment).

As for dep. claim 4 (part of 1), which deals with a source of data entry for an entry above, i.e. from a template, this is non-essential to the scope of the claimed invention and is fairly shown in Fig. 18B. Alternatively, the use of other similar modules (Fig. 1, 18) containing template format would have been obvious as mere using other module format to achieve similar results. As for the limitation “not produced by an end

user”, this is inherently included in the teachings of MORGAN et al. Moreover, this carries little patentable weight since it’s a negative limitation and in a passive state.

✓ **As for dep. claim 5** (part of 1), which deals with similar limitation as in dep. claim 4 above, it’s rejected for the same reason set forth in dep. claim 4 above.

As for dep. claim 6 (part of 1), which deals with well known organization type parameter, i.e. department or whole company, this is fairly taught in c1:56, or c2:40-57.

As for dep. claim 22 (part of 1), which deals with well known task information parameters or type of task information, i.e. projected volume/quantity and duration, this is non-essential to the scope of the claimed invention and is fairly taught in c3:66 – c4:11, c17:50-55 “*product volumes ... for any number of months*”, c18:30-35.

As for independent method² claim 7, which has similar limitation as in independent method claim 1 (combining receiving steps (a) and (b) into 1 step), it’s rejected for the same reason set forth in claim 1 above.

As for dep. claim 8 (part of 7), which deals with well known organization input parameters, i.e. activity entry or task entry, this is fairly taught in c4:1-4.

As for dep. claim 9 (part of 7), which deals with well known organization input parameters, i.e. system entry, this is fairly taught in c4:1-4 or c4:22-24.

As for dep. claim 10 (part of 7), which deals additional limitation of “determining a demand” for a specific entry such as system, this is inherently included c4:1-10 wherein a forecast or trend report is determined.

As for dep. claim 11 (part of 7), which deals immaterial modification, type of forecast report, this is inherently included c4:1-10 "value-added report" or would have been obvious to a skilled artisan as mere selection other similar type of report for intended purpose.

As for dep. claim 12 (part of 7), which has similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in claim 4 above.

As for independent method³ claim 19, which has similar limitation as in independent method claims 1, 3, 5 (combining receiving steps (a) and (b) into 1 step), it's rejected for the same reason set forth in claim 1 above.

As for dep. claims 20-21 (part of 7), which have similar limitations as in dep. claims 5-6 (part of 1) respectively above, they are rejected for the same reason set forth in claims 5-6 above.

15. Claims 1-6, 22, 7-12, 19-21, 23 and 24 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over CALVER (US 2001/00132092).

As for independent method¹ claim 1, MORGAN et al fairly teaches a method for activity-based business modeling for an organization comprising the steps of {see Fig. 16):

(a) receiving a plurality of task entries (filled template), wherein each task entry is comprised of defined types of future action which will generate a result { [0080, 0081]]};

(b) receiving a plurality of resource entries, wherein each resource entry indicates any associated personnel, hardware, software (or equipment which normally includes computer, computer system and other IT equipment, see also c4:22 "hardware, software") and services {see 0052, 0054, 0082}};

(c) receiving mapping information showing relationship between the task entries and resource entries {see 0127, 0128, Fig. 15, 16};

(d) processing the plurality of task entries, resource entries and mapping information to formulate a business model {see [0127, 0128}};

(e) generating a forward-looking (or forecast) report after (d) and related to the business model" {see [0084}.

As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, this is inherently included in the teaching of CALVER since no mentioning of taking historical data from a general hedger.

As for dep. claim 2 (part of 1), which deals with well known organization cost/expense parameter, i.e. overhead, this is fairly taught in Fig. 15 or Fig. 16.

As for dep. claim 3 (part of 1), which deals with well known organization resource parameters, i.e. a system or apparatus, this is fairly taught in Fig. 15, 16.

As for dep. claim 4 (part of 1), which deals with a source of data entry for an entry above, i.e. from a template, this is non-essential to the scope of the claimed invention and is fairly shown in [0065, 0068, 0069]. Alternatively, the use of other similar modules containing template format would have been obvious as mere using

Art Unit: 3629

other module format to achieve similar results. As for the limitation "not produced by an end user", this is inherently included in the teachings of CALVER. Moreover, this carries little patentable weight since it's a negative limitation and in a passive state.

As for dep. claim 5 (part of 1), which deals with similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in dep. claim 4 above.

As for dep. claim 6 (part of 1), which deals with well known organization type parameter, i.e. department or whole company, this is fairly taught in Fig. 16, 0054, 0070.

As for dep. claim 22 (part of 1), which deals with well known task information parameters or type of task information, i.e. projected volume/quantity and duration, this is non-essential to the scope of the claimed invention and is fairly taught in Figs. 15, 16, 0139, 0140, 0141.

As for independent method² claim 7, which has similar limitation as in independent method claim 1 (combining receiving steps (a) and (b) into 1 step), it's rejected for the same reason set forth in claim 1 above.

As for dep. claim 8 (part of 7), which deals with well known organization input parameters, i.e. activity entry or task entry, this is fairly taught in 0068-0071.

As for dep. claim 9 (part of 7), which deals with well known organization input parameters, i.e. system entry, this is fairly taught in Fig. 6, 0068-0069.

As for dep. claim 10 (part of 7), which deals additional limitation of "determining a demand" for a specific entry such as system, this is inherently included [0082-0084, 0139, 0140] wherein a forecast or trend report is determined.

As for dep. claim 11 (part of 7), which deals immaterial modification, type of forecast report, this is inherently in Figs. 15 and 16.

As for dep. claim 12 (part of 7), which has similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in claim 4 above.

As for independent method³ claim 19, which has similar limitation as in independent method claims 1, 3, 5 (combining receiving steps (a) and (b) into 1 step), it's rejected for the same reason set forth in claim 1 above.

Response to Arguments

16. Applicant's arguments (3 major) filed 5/5/2005 have been fully considered but they are not persuasive.

1) Applicant's request for a clearer explanation of the 35 U.S.C.101 rejection is shown on paragraph 2 above.

2) Applicant's comment that Morgan teaches a "backward facing" activity based management system and not "future action" as in the claimed invention is not persuasive because the limit "future action" reads over "forecasting" or "trend", etc., as taught by Morgan on col. 4, lines 5-10, c19:52-67. Moreover, the use of "historical data" with respect to cost (from a general ledger) for forecasting is for producing a realistic, operational, and meaningful view of how the money was spent {see col. 4, lines 25-28}; however, as mentioned above, if producing a realistic, operational, and meaningful view of how the money was spent is not

Art Unit: 3629

critical or the if historical data (general ledger) is not available, then it would have been obvious to bypass it (the usage of historical financial data) if desired.

3) Applicant's comment that the claimed invention produces "dynamic modeling" based on inputs related to the tasks to be completed and it allows for the modeling of different activity levels" is noted, however, these terms "dynamic modeling" and "different activity levels" are not in the claim. Furthermore, they are relative or "subjective" language that receive little patentable weight.

No claims are allowed.

Art Unit: 3629

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

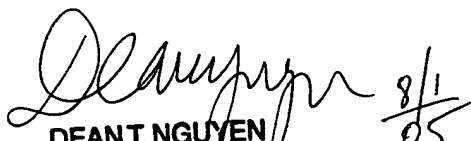
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
August 1, 2005


DEANT. NGUYEN
PRIMARY EXAMINER